REMARKS

To further prosecution of the instant application, Applicant has amended herein Claims 27, 32-35, 37045, 48 and 66. Applicant respectfully requests reconsideration.

Applicant also has cancelled herein Claims 36, 51-54, 60-61, 64-65 and 67072 without prejudice to the subject matter contained herein and with reservation to pursue the subject matter of such Claims in one or more continuation and/or divisional applications.

In addition, Applicant has added herein new Claims 73-76. New Claims 73-76 do not add subject matter and have antecedent basis.

Claims 27-35, 37-49, 59, 66 and 73-75 are currently pending in the instant application with Claims 59, 66 and 73 in independent form.

Claim Amendments

Independent Claim 59 has been amended herein to clarify Applicant's invention. An amended limitation is directed to, "wherein said processing and converting said input data into said output data includes a determination by said secondary insurer of whether said one or more underwriting standards [of said primary insurer] meets one or more criteria said secondary insurer applies to determine if said secondary insurer can rely upon said underwriting approval of said primary insurer for said primary insurance policy to provide said secondary insurance policy;" and "if said secondary insurer can rely upon said underwriting approval of said primary insurer based upon said determination, using said output data to define and to issue said secondary policy . . . " The amended language has antecedent basis in the specification in page 3, lines 1-23, page 6, line 28 to page 7, line 20, and page 7, lines 28-32.

The added limitation of Claim 59 directed to, "said secondary insurer being a different insuring entity from said primary insurer and said secondary insurance policy being a separate policy from said primary insurance policy" has antecedent basis in page 13, line 33 to page 14, line 21 of the specification. In addition, the added limitation directed to, "wherein said payment of said at least one secondary benefit amount is not conditioned upon payment of one or more benefit amounts provided by said primary insurance policy" has antecedent basis in the specification in page 11, lines 22-26.

Independent Claim 66 has been amended herein to clarify Applicant's invention. An amended limitation is directed to, "said additional insurance policy being issued by a second or other insurer, said second or other insurer being a different insuring entity from said prior insurer and said additional insurance policy being a separate policy from said previously issued insurance policy" has, as noted above, antecedent basis in page 13, line 33 to page 14, line 21.

In addition, added limitation of Claim 66 directed to, "wherein payment of said at least one benefit amount is not conditioned upon payment of any benefits provided by said previously issued insurance policy" has antecedent basis in the specification in page 11, lines 22-26.

Rejection of Claims 59-61 and 64-69 Under 37 C.F.R. 112

Claims 59-61 and 64-69 have been rejected under 37 C.F.R. § 112, first paragraph, as containing subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claim invention. In particular, the Examiner has indicated she was unable to find any support for the newly added language within the specification. Without acceding to the Examiner's conclusion, Claims 60-61, 64-65 and 67-69 have been cancelled from the instant application, and independent Claims 59 and 66 have been amended herein to delete language including the term "independent" as well as other language the Examiner's Action identifies as lacking support in the specification. As provided by the foregoing amendments and as discussed above, Claims 59 and 66 include amended language having antecedent basis in the specification. Applicant respectfully submits Claims 59 and 66 are in compliance with 37 C.F.R. § 112, first paragraph, and respectfully requests withdrawal of the rejection.

Claims 59, 61, 64, 66 and 68 have been rejected under 37 C.F.R. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. As noted above, and without acceding to the Examiner's conclusion, Claims 61, 64 and 68 have been cancelled from the instant application, and Claims 59 and 66 have been amended to delete language including the term "independent." Applicant respectfully submits Claims 59 and 66 are

in compliance with 37 C.F.R. § 112, second paragraph, and respectfully requests withdrawal of the rejection.

Rejection of Claims 59-61, 27-31, 44-45, 51-54 and 64-72 Under 35 U.S.C. § 103(a)

Claims 59-61, 27-31, 44-45, 51-54 and 64-72 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. 5,873,006 to Underwood (*Underwood*), and further in view of Ferling et al., "New Plans, New Policies," April 1991 (*Ferling*). As indicated above, Applicant has cancelled Claims 51-54, 60-61, 64-65 and 67-72. Applicant respectfully traverses the rejection of the remaining pending Claims in view of the cited combination of prior art references for the reasons set forth below.

Applicant respectfully submits that independent Claims 59 and 66 are not obvious in view of the cited combination of prior art references to *Underwood* and *Ferling*, and further are not obvious in view of the prior art of record. Applicant respectfully submits that the teachings of *Ferling* would not motivate one of ordinary skill in the art to modify *Underwood* to arrive at the invention of Claim 59 or the invention of Claim 66 because the cited combination would not achieve the inventions specified in these Claims.

More specifically, the cited combination would not achieve at least the limitations of Claim 59 specifying, "said secondary insurer being a different insuring entity from said primary insurer, and said secondary insurance policy being a separate policy from said primary insurance policy . . ." *Ferling* fails to disclose any teaching or suggestion that would motivate one of ordinary skill in the art to modify *Underwood* to provide additional insurance as a secondary insurance policy whereby such policy is a separate policy and is issued by a secondary insurer that is a different insuring entity from a primary insurer of a primary insurance policy, whose underwriting approval is relied upon by the secondary insurer to provide the secondary insurance policy.

Ferling discloses three insurance products, including a Benefit Increase Option, a Guaranteed Insurability Rider and a Living Benefit Rider. The Benefit Increase Option and the Guaranteed Insurability Rider are options available for the insured to select to increase the annual benefits of an existing policy, such as nursing home care benefits policy. The Benefit Increase Option is an option provided under an existing insurance policy that automatically increases the nursing home benefit by 5% of the prior year's

benefit. The Guaranteed Insurability Rider is a rider also provided under an existing insurance policy that allows the insured to increase nursing home care benefits on each anniversary of the policy. Both the Option and Rider allow the insured to increase nursing home care benefits provided under their existing policy without "evidence of insurability." (See *Ferling*, page 2, para. 4-6).

The Examiner indicates in the Action that "without evidence of insurability" is interpreted to teach a form of relying on the underwriting approval of the primary insurer and that such teaching of *Ferling* would motivate one of ordinary skill to modify *Underwood* to increase benefits without evidence of insurability. Applicant respectfully submits that the invention of Claim 59 is not directed to increasing benefits of an existing or primary insurance policy, but, rather, is directed to increasing total benefits of the insured with an additional or secondary insurance policy provided by a secondary insurer where the secondary insurer is a different insuring entity than the existing or primary insurer and the secondary insurance policy is a separate policy from the primary policy provided by the primary insurer. The secondary policy is issued by the secondary insurer based upon the secondary insurer's determination of whether it may rely upon the primary insurer's underwriting approval of the insured for the primary policy.

The Option or Rider taught by *Ferling* is not issued by a secondary insurer that is a different insuring entity from a primary insurer. Nor is the Option or Rider a secondary insurance policy that is a separate policy from the primary insurance policy. Rather, the Option or Rider is provided by the same insurer, or, in other words, the primary insurer providing the existing or primary policy. Further, the Option or Rider is not a separate policy from the existing or primary policy, but is an option provided under the existing or primary policy that the insured selects and the existing or primary insurer provides. Therefore, the teachings of *Ferling* are in direct contrast to the above-noted limitations of Claim 59 that specify "said secondary insurer being a different insuring entity from said primary insurer, and said secondary insurance policy being a separate policy from said primary insurance policy."

Further, the Option or Rider of *Ferling* is provided "without evidence of insurability." However, as the Option or Rider is related to the existing or primary policy and is provided by the same or primary insurer, the same or primary insurer has

previously underwritten the insured for the existing or primary policy such that "without evidence of insurability" in this context relates to the same or primary insurer providing the Option or Rider without performing further underwriting of the insured. This is in contrast to a secondary insurer, which is different from the primary insurer, relying upon the underwriting approval of the primary insurer for a primary insurance policy to provide the secondary insurance policy. Therefore, this teaching of *Ferling* is different from those claim limitations of Claim 59 discussed above and does not provide any suggestion, teaching or motivation for such limitations.

In addition, the teachings of *Ferling* lack a teaching, suggestion or motivation for modifying *Underwood* to achieve the limitations of Claim 59 directed to, "wherein said processing and converting said input data into said output data includes a determination by said secondary insurer of whether said one or more underwriting standards [of said primary insurer] meets one or more criteria said secondary insurer applies to determine if said secondary insurer can rely upon said underwriting approval of said primary insurer for said primary insurance policy to provide said secondary insurance policy; and if said secondary insurer can rely upon said underwriting approval of said primary insurer based upon said determination, using said output data to define and to issue said secondary insurance policy."

With respect to the Living Benefit Rider that *Ferling* discloses, the Rider permits the prepayment of a portion of a death benefit if the insured is terminally ill. The Rider is "a separate product" that is available on regularly underwritten life policies, and is not available on in-force policies, but is available if a new policy is purchased with the Rider. In addition, *Ferling* discloses the Rider must be requested in the application and no premium or deduction is charged for the Rider. (See *Ferling*, page 2, para. 7-9).

The Examiner indicates in the Action that "a separate product" is interpreted to teach a form of providing a secondary insurance policy that is different from the primary insurance policy and any benefits of the primary insurance policy. Applicant respectfully submits that *Ferling* discloses the Rider is not available on in-force or existing policies, but is available if a new policy is purchased with the Rider and the Rider is specifically requested in the application. This teaching of *Ferling* indicates that the Rider is a separate product only by way of prepayment of the death benefit of the underlying life

insurance policy in the event the insured is terminally ill. In addition, Applicant respectfully submits that *Ferling* does not teach or suggest the Rider provides additional insurance via a secondary insurance policy where the secondary insurance policy is a separate policy from an existing or primary policy. Rather, *Ferling* discloses that the Rider is only available if purchased with a life insurance policy. Further, Applicant respectfully submits that the Rider of *Ferling* is not a secondary insurance policy issued by a secondary insurer that is a different insuring entity from the existing or primary insurer that provides the primary policy or the life insurance policy purchased commensurate with the Rider. Rather, the Rider is purchased from the same insurer that provides the primary policy or the life insurance policy.

Applicant respectfully submits that the Benefit Increase Option, the Guaranteed Insurability Rider and the Living Benefit Rider of *Ferling* do not provide a teaching, suggestion or motivation such that one of ordinary skill in the art would modify *Underwood* to provide additional insurance for one or more persons as a secondary insurance policy provided by a secondary insurer, based upon an underwriting approval of the one or more persons provided by a primary insurer for a primary insurance policy, where the secondary insurer is a different insuring entity from the primary insurer and the secondary insurance policy is a separate policy from the primary insurance policy.

Thus, Applicant respectfully submits that the teachings of *Ferling* combined with *Underwood* fail to achieve the invention of Claim 59.

Similarly, with respect to independent Claim 66, Applicant respectfully submits that the cited combination of prior art references to *Underwood* and *Ferling* does not achieve the invention specified in Claim 66, nor does *Ferling* provide a teaching, suggestion or motivation for one of ordinary skill in the art to modify *Underwood* to achieve the claimed invention. More specifically, the cited combination does not teach or suggest the limitations to, "determining whether said prior insurer provided an underwriting approval of said one or more persons for said previously issued insurance policy" and "if said prior insurer provided said underwriting approval of said one or more persons for said previously issued insurance policy, issuing said additional insurance policy based upon said determination to provide additional insurance for said one or more

persons, said determination made by a second or other insurer and said additional insurance policy being issued by said second or other insurer, said second or other insurer being a different insuring entity from said prior insurer and said additional insurance policy being a separate policy from said previously issued insurance policy . . . "

Thus, Applicant respectfully submits that the teachings of *Ferling* combined with *Underwood* do not achieve the invention of Claim 66.

In conclusion, the cited combination of prior art references does not provide a teaching, suggestion or motivation such that one of ordinary skill in the art would arrive at the claimed invention specified in Claim 59 or Claim 66. In particular, *Ferling* does not teach, suggest or motivate one of ordinary skill in the art to modify *Underwood* to include at least those limitations of Claims 59 and 60 discussed above. Rather, the teachings of *Ferling* are in direct contrast to these limitations.

Thus, Claims 59 and 60 are not obvious in view of the cited combination or prior art references or the prior art of record and are therefor patentably distinct. Accordingly, Applicant respectfully requests withdrawal of the rejection of Claim 59 and Claim 66 under 37 C.F.R. § 103(a).

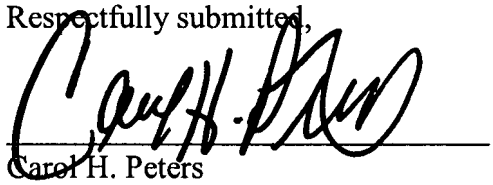
Claims 27-35 and 37-49 depend from Claim 59 and are patentable for the reasons given above. Applicant therefore respectfully requests withdrawal of the rejection of dependent Claims 27-35 and 37-49 under 37 C.F.R. § 103(a).

Patentability of New Claims 73-76

Applicant respectfully submits that new Claims 73-76 are patentably distinct over the cited combination of references and the prior art of record for one or more of the reasons given above.

Based upon the foregoing amendments and discussion, the instant application is in condition for allowance and an action to this effect is respectfully requested. Should Examiner Pass have any questions concerning this response, she is invited to telephone the undersigned.

Respectfully submitted,



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